UNITED STATES DEPARTMENT OF COMMERCE
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07/657296

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
07/657,296	02/19/91	SCHATZ	R	1207.0008

EXAMINER
PREBILIC,P

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ART UNIT	PAPER NUMBER
3308	22

DATE MAILED: 01/15/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 11-18-91 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-6 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-6 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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EXAMINER'S ACTION

PTOL-326 (Rev.9-89)

The drawings are objected to because Figures 1A, 1B, 3, 4, 5, and 6 are clearly depictions of prior art devices; see any one of the three Palmaz patents of record. Therefore, these figures should be labeled as "PRIOR ART" in order to distinguish the present invention from the prior art. The Applicant is respectfully requested to submit proposed drawing changes with the response to this Office Action. Correction is required. Failure to submit proposed correction or proposed substitute drawings will result in the response hereto being deemed non-responsive.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-6 are provisionally rejected under 35 U.S.C. 103 as being obvious over copending application Serial No. 07/174,246.

Copending application Serial No. 07/174,246 has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 103 is based upon a presumption of future patenting of the conflicting application.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any unclaimed invention disclosed in the copending application was derived from the inventor of this application and is thus not the invention "by another", or by a showing of a date of invention

prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

Claims 1-6 directed to an invention not patentably distinct from claims 25-36 of commonly assigned 07/174,246.

Specifically, the only difference between the presently claimed subject matter and the subject matter claimed in the copending application is the copending application claims a plurality of connectors between adjacent stents whereas the present application claims "only one" connector where "only one" can constitute more than one connector. It is the examiner's position that the subject matters claimed in the two applications at least overlap one another and that it would have been obvious to use a plurality of connectors situated within 45% of one another in the copending application. In other words, one in the art would consider it obvious to situate the connectors close to one another if more angular flexibility were desired.

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-36 of copending application serial no. 07/174,246. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the presently claimed subject matter and the subject matter claimed in the copending application is the copending application claims a plurality of connectors between adjacent stents whereas the present application claims "only one" where "only one" can be more than one connector. It is the examiner's position that the subject matter claimed in the two applications at least overlap one another and that it would have been obvious to use a plurality of connectors situated within 45% of one another in the copending application. In other words, one in the art would consider it obvious to situate the connectors close to one another if more angular flexibility was desired..

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claims 1-6 would be allowable over the prior art of record once the double patenting rejections are overcome.

An inquiry concerning this communication should be directed to Paul Prebilic at telephone number (703).308-0858

PAUL PREBILIC
PATENT EXAMINER
ART UNIT 338

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